

REMARKS

Reconsideration and reexamination are requested.

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CLAIMS PRESENTED

Claims 1-43 are now presented. Claim 20 is as originally filed. Claims 1-4, 8-16, 19, 25-31 and 42 are currently amended. No claims have been cancelled, withdrawn, or not entered. Claims 5-7, 17, 18, 21-24, 32-41 and 43 were previously presented other than as original claims. No new claims are now presented. Of the claims previously presented, but not currently amended, Claims 5-7, 17, 18 and 21-24 were previously amended (17 and 18 by the Examiner) and are retained as so amended; and Claims 32-41 and 43 were previously added by amendment, and are retained unamended as so added.

All of the currently presented claims are set out above at pages 2-9, in accordance with the procedures recited in *Changes To Implement Electronic Maintenance of Official Patent Application Records*, 68 Federal Register 38611-30 (June 30, 2003), amending 37 C.F.R. § 1.121 and other sections effective July 30, 2003.

APPLICABLE LAW

In rejecting the claims, the Examiner relies on 35 U.S.C. 102(e), in some cases to support an anticipation rejection, in other cases in combination with 35 U.S.C. 103 to support an obviousness rejection.

The Examiner states that –

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

The Examiner's statement is believed to be in error, as the Examiner is apparently working with a version of the statute recently rendered obsolete. This Application should be examined under 35 U.S.C. 102(e) as it reads *after* the amendment by the AIPA (*post-AIPA* 35 U.S.C. 102(e)). (As presently advised, however, and as discussed below at pages 13-15, the effective date of the 1999 amendment to 35 U.S.C. 102(e) is moot.)

35 U.S.C. 102(e) was in fact amended by Section 4505 of the AIPA (Public Law 106-113, November 29, 1999). The effective date of the amendment was originally stated, in Section 4508 of the AIPA, to be as indicated by the Examiner. However, Section 4508 of the AIPA was itself amended by the Intellectual Property and High Technology Technical Amendments Act of 2002 (Public Law 107-273, November 2, 2002).

Section 4508 of the AIPA now states that –

... Except as otherwise provided in this section, the amendments made by section 4505 shall be effective as of November 29, 2000 and shall apply to *all patents and all applications for patents pending on or filed after November 29, 2000*. Patents resulting from an international application filed before November 29, 2000 and applications published pursuant to section 122(b) or Article 21(2) of the treaty defined in section 351(a) resulting from an international application filed before November 29, 2000 shall not be effective as prior art as of the date of the international application; however, such patents shall be effective as prior art in accordance with section 102(e) in effect on November 28, 2000.

116 Stat. 1904, emphasis supplied.

Further information concerning the 1999 amendment to 35 U.S.C. 102(e), and the 2002 amendment of the effective date, are provided in MPEP § 706.02(f)(1), Examination Guidelines for Applying References Under 35 U.S.C. 102(e) (Rev. 1, Feb. 2003); in the USPTO Web Site

under "AIPA American Inventor's Protection Act of 1999"; and in *Examination Guidelines for 35 U.S.C. 102(e)*, as amended by the American Inventors Protection Act of 1999, and further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002, and 35 U.S.C. 102(g) (Revised), 1299 O.G. 77 (January 14, 2003).

The present application was filed April 25, 2000. It is, therefore, an application for patent "*pending on* or filed after November 29, 2000". The *post-AIPA* 35 U.S.C. 102(e) is now the law that applies to references asserted to apply to this Application by virtue of 35 U.S.C. 102(e). As discussed below (pages 14-15), according to that law, WIPO (PCT) publications directly resulting from international applications under PCT Article 21(2) are *never references under 35 U.S.C. 102(e)* if the international application has an *international filing date prior to November 29, 2000*. Such PCT publications may, however, be applied as prior art as of their *publication dates* under 35 U.S.C. 102(a) or (b).

REFERENCES APPLIED

The Examiner applies four references:

- A. U.S. Patent No. 5,464,369, issued November 7, 1995, to Federspiel;
- B. U.S. Patent No. 6,150,927, issued November 21, 2000, to Nesbitt (filed March 30, 1998);
- C. U.S. Patent No. 6,222,442, issued April 24, 2001, to Gager et al. (filed March 29, 1999); and
- D. S.S. Kim, PCT International Patent Application, Publication No. WO 99/04119, published January 28, 1999.

Federspiel is available as a statutory bar reference, under 35 U.S.C. 102(b), as a U.S. Patent issued more than a year prior to the April 26, 1999, effective filing date of the present Application. (Applicants claim priority of Provisional U.S. Application 60/131,189, filed April 26, 1999).

Nesbitt is *prima facie* available as a reference under 35 U.S.C. 102(e), as a U.S. Patent issued on an application filed March 30, 1998, prior to the April 26, 1999, effective filing date of the present Application.

Gager is *prima facie* available as a reference under 35 U.S.C. 102(e), as a U.S. Patent issued on an application filed March 29, 1999, prior to the April 26, 1999, effective filing date of the present Application.

Kim is *prima facie* available as a reference under 35 U.S.C. 102(a), as a publication published January 28, 1999, prior to the April 26, 1999, effective filing date of the present Application. Kim is *not* available as a reference under 35 U.S.C. 102(b), as it was not published more than a year prior to the April 26, 1999, effective filing date of the present Application.

Kim is *not* available as a reference under 35 U.S.C. 102(e), as discussed below at pages 13-15 of this Amendment. A U.S. Patent that is *based on* Kim may *become* available as a reference under 35 U.S.C. 102(e), if such a U.S. Patent is issued.

With respect to Nesbitt, Gager and Kim, the Examiner has *presumed* Applicants' date of invention to be Applicants' date of constructive reduction to practice, April 26, 1999, the earliest date of invention shown in the file history of the present Application as of the date of the Office Action. The Examiner's presumption is rebuttable, and is in fact rebutted by Declarations Under 37 CFR 1.131 submitted herewith.

THE EFFECTIVE DATE OF THE 1999 AMENDMENT IS MOOT

As it turns out, the effective date of the 1999 amendment to 35 U.S.C. 102(e) is moot, as presently advised. Federspiel is a statutory bar under 35 U.S.C. 102(b), and 35 U.S.C. 102(e) is not relevant. Nesbitt and Gager are *prima facie* available as references under 35 U.S.C. 102(e), as of their U.S. filing dates, regardless of whether the pre-AIPA or the post-AIPA version of 35 U.S.C. 102(e) is applied.

Kim, however, is *not* available as a reference under 35 U.S.C. 102(e), and is *prima facie* available as a reference *only under 35 U.S.C. 102(a), as of its January 28, 1999, publication date*, regardless of whether the pre-AIPA or the post-AIPA version of 35 U.S.C. 102(e) is applied.

According to the **pre-AIPA version of 35 U.S.C. 102(e)**, a copy of which is quoted by the Examiner at page 2 of the Office Action of May 14, 2003,

"A person is entitled to a patent unless – ...

"(e) the invention was described in a *patent* granted

“[i] on an *application for patent by another filed in the United States* before the invention thereof by the applicant for patent, or

“[ii] on an *international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c)* of this title before the invention thereof by the applicant for patent.”

(Emphasis, bracketed material and paragraphing supplied.)

The pre-AIPA version of 35 U.S.C. 102(e) requires first a *patent*. Kim is not a patent, but only a PCT publication. Secondly, the pre-AIPA version of 35 U.S.C. 102(e) requires that the patent be granted on either [i] on an *application for patent by another filed in the United States* before the invention thereof by the applicant for patent, or [ii] on an *international application by another who has fulfilled the requirements of 35 U.S.C. 371(c)(1), (2), and (4)* before the invention thereof by the applicant for patent. (35 U.S.C. 371(c)(1), (2), and (4) require a filing fee, a copy of the international application, and an inventor's declaration or oath to be filed in the USPTO.)

The record does not show what, if anything, inventor Kim has done to obtain a patent in the United States, besides designate the U.S. in his PCT Application. So far as the present record shows, inventor Kim has neither filed a U.S. application before the invention date of Applicants, nor filed an international application and *fulfilled the requirements of 35 U.S.C. 371(c)(1), (2), and (4)* before the invention date of Applicants. We do not know if inventor Kim has filed a U.S. application at all, as designating the U.S. on an international application is not filing an application in the United States. Searches for a U.S. patent or published U.S. patent application that corresponds to the Kim PCT Application have not been successful in finding one.

Inventor Kim *did* file an international application, but we do not know if he *fulfilled the requirements of 35 U.S.C. 371(c)(1), (2), and (4)* before the invention date of Applicants, or ever.

So under the *pre-AIPA* version of 35 U.S.C. 102(e), Kim would not be a reference as of Kim's filing date.

According to the *post-AIPA* version of 35 U.S.C. 102(e), see MPEP § 706.02(f)(1), at page 700-27, col. 2, paragraphs (3) and (3)(b):

(3) If the international application has an international filing date prior to November 29, 2000, ...

(b) **For U.S. application publications and WIPO [PCT] publications directly resulting from international applications under PCT Article 21(2), never apply these references under 35 U.S.C. 102(e). These references may be applied as of their publication dates under 35 U.S.C. 102(a) or (b).**

(Emphasis supplied.)

See also the *Examination Guidelines for 35 U.S.C. 102(e)*, as amended by the *American Inventors Protection Act of 1999*, and further amended by the *Intellectual Property and High Technology Technical Amendments Act of 2002*, and 35 U.S.C. 102(g) (Revised), 1299 O.G. 77 (January 14, 2003), third paragraph:

... A U.S. or WIPO publication of an international application filed prior to November 29, 2000 will have no prior art effect under [35 U.S.C.] § 102(e). Such publications do, however, have prior art effect under [35 U.S.C.] § 102(a) or (b) as of their publication dates."

So under the *post-AIPA* version of 35 U.S.C. 102(e), Kim is not a reference as of Kim's filing date, either. With respect to references now applied to the claims, and in particular with respect to the applied Kim PCT publication, the effective date of the 1999 amendment to 35 U.S.C. 102(e) is moot.

REJECTIONS APPLIED BY EXAMINER

The Examiner rejects –

(1) Claims 1 and 27-29 under 35 U.S.C. 102(e) as being anticipated by Gager U.S. Patent 6,222,442 B1;

(2) Claim 29 under 35 U.S.C. 102(e) as being anticipated by Kim PCT Publication WO 99/04119;

(3) Claims 2-12, 14-26 and 30-43 under 35 U.S.C. 103(a) as being unpatentable (obvious) over Gager in view of Federspiel U.S. Patent 5,464,369;

(4) Claim 13 under 35 U.S.C. 103(a) as being unpatentable (obvious) over Gager in view of Federspiel, and further in view of Nesbitt U.S. Patent 6,150,927; and

(5) Claims 1, 27, 30, 31, 40 and 42 under 35 U.S.C. 103(a) as being unpatentable (obvious) over Kim in view of Federspiel.

Although Kim is *not* available as a reference under 35 U.S.C. 102(e), Kim *is, prima facie*, available as a reference under 35 U.S.C. 102(a), as a publication published January 28, 1999,

before the April 26, 1999, effective filing date of the present Application. Accordingly, the present Amendment responds to the Office Action of May 14, 2003, as though the Examiner had applied Kim under 35 U.S.C. 102(a), as a publication published January 28, 1999.

RESPONSE TO REJECTIONS APPLIED BY EXAMINER

(a) Applicants' Amendments:

Applicants have amended Claims 1, 16, 19 and 27-30, to recite detecting the *respiration* of a living *person or animal*, rather than reciting detecting the *presence* of a *respiring* living *organism*; Claim 31, to recite detecting the *breathing* of a breathing individual, rather than reciting detecting the *presence* of a breathing individual; and Claim 42, to recite *breathing*, rather than *at least one bodily function* or *at least one bodily function ... wherein said at least one bodily function comprises breathing*. Various claims have been amended to recite *respiration*, rather than reciting *presence*; and to recite living *person or animal*, rather than reciting living *organism*. By so amending the claims, Applicants focus the claims on the specific contribution of Applicants to the state of the art that Applicants wish to claim at this time, including the detection of *respiration* rather than the detection of *movement*, which can lead to false-positive detections. The claims have been amended to recite *person or animal*, rather than *organism*, because not every living organism breathes, in the sense that people and animals do.

(b) Rejections Based in Whole or in Part on Gager:

With reference to the list of rejections above at page 15, the Examiner rejects (1) Claims 1 and 27-29 under 35 U.S.C. 102(e) as being anticipated by Gager; (3) Claims 2-12, 14-26 and 30-43 under 35 U.S.C. 103(a) as being unpatentable (obvious) over Gager in view of Federspiel; and (4) Claim 13 under 35 U.S.C. 103(a) as being unpatentable (obvious) over Gager in view of Federspiel, and further in view of Nesbitt.

Gager relates to a vehicle (automobile) trunk compartment emergency release and warning system and method to release a trunk latch and warn the vehicle operator of the presence of a person locked in the trunk. (See Gager at column 1, lines 1-12.) Gager has an effective date under 35 U.S.C. 102(e) of March 29, 1999.

Gager's apparatus claims recite "a presence detector ... to detect motion" in a vehicle trunk (Claim 1, column 5, lines 46-47; Claim 3, column 6, lines 7-8; and Claim 5, column 6, lines 27-28), and components that function in various ways "upon detection of motion" in the vehicle trunk (Claim 1, column 5, lines 48-55; Claim 3, column 6, lines 9-16; and Claim 5, column 6, lines 29-36). Gager's method claims recite "detecting motion" in a vehicle trunk (Claim 6, column 6, line 48; Claim 8, column 7, line 1; and Claim 11, column 8, line 4.)

Applicant's method claims now claim a method which comprises detecting the *respiration* of a living *person or animal*, rather than detecting the *presence* of a *respiring* living *organism*. Applicant's apparatus Claim 20 claims apparatus which comprises a CO₂ detector. Applicant's detection system Claims 31-39, method Claims 40 and 41, and assembly Claims 42 and 43 (all copied or substantially copied from claims of Miller et al. U.S. Patent 6,130,614) likewise recite detecting breathing. Applicant's Claims 40, 41 and 43 also call for a CO₂ detector, like Applicant's Claim 20.

Gager therefore does *not* claim the *same patentable invention as defined in 37 CFR § 1.601(n)*, as is claimed by Applicants. Detecting breathing, or inferring the presence of a person or animal by detecting CO₂, is patentably distinct from inferring the presence of a person by detecting movement.

Accordingly, an interference between Applicants and Gager is *not* appropriate, but the presentation of declarations under 37 CFR § 1.131 to antedate the Gager *is* appropriate.

Applicants therefore present the enclosed declarations under 37 CFR § 1.131, to antedate the Gager reference. The rejections that are based in whole or in part on Gager should therefore be withdrawn.

Additional comments could be made concerning the propriety of applying Gager to Applicants' Claims 1-43, apart from the completion of Applicants' invention prior to Gager's filing date; concerning the propriety of applying Federspiel to Applicants' Claims 2-14, 15-26 and 30-43; and concerning the propriety of applying Nesbitt to Applicants' Claim 13. Any such comments would be redundant in view of the anticipated withdrawal of the rejections that are based in whole or in part on Gager, based on the enclosed declarations under 37 CFR § 1.131.

(c) Rejections Based in Whole or in Part on Kim:

With reference to the list of rejections above at page 15, the Examiner rejects (2) Claim 29 under 35 U.S.C. 102(e) as being anticipated by Kim PCT Publication WO 99/04119, and (5) Claims 1, 27, 30, 31, 40 and 42 under 35 U.S.C. 103(a) as being unpatentable (obvious) over Kim in view of Federspiel.

Kim relates to apparatus for the emergency opening of automobile trunk lids, and has an effective date under 35 U.S.C. 102(a) of January 28, 1999.

Kim is not a U.S. Patent, only a PCT publication of an international application. As far as Applicants are aware, no U.S. patent has been issued for the invention disclosed in Kim, nor has a U.S. patent application for such an invention even been filed.

Accordingly, an interference between Applicants and Kim *not* appropriate, but the presentation of declarations under 37 CFR § 1.131 to antedate Kim *is* appropriate.

Applicants therefore present the enclosed declarations under 37 CFR § 1.131, to antedate the Kim reference. The rejections that are based in whole or in part on Kim should therefore be withdrawn.

Additional comments could be made concerning the propriety of applying Kim to Applicants' Claims 1, 27, 29-31, 40 and 42, apart from the completion of Applicants' invention prior to Kim's publication date; and concerning the propriety of applying Federspiel to Applicants' Claims 1, 27, 30, 31, 40 and 42. Any such comments would be redundant in view of the anticipated withdrawal of the rejections that are based in whole or in part on Kim, based on the enclosed declarations under 37 CFR § 1.131.

(d) Applicants' Declarations Under 37 CFR § 1.131:

The enclosed Declarations show conception and reduction to practice before January 28, 1999. The rejections based in whole or in part on Gager or Kim should therefore be withdrawn.

POSSIBLE INTERFERENCE

On September 28, 2001, Applicants copied or substantially copied Claims 1-8, 10, 12 and 14-16 of Miller et al. U.S. Patent 6,130,614, issued October 10, 2000, hereinafter the "Miller '614 Patent", as Application Claims 31-43, respectively, for purpose of interference.

Reexamination of the Miller '614 Patent was ordered September 9, 2003, Control No. 90/006,690, filed July 1, 2003 (see Official Gazette for August 26, 2003). In the event that all of the claims of the Miller '614 Patent are cancelled as a result of the Reexamination, an interference would be precluded. In the event that most of the claims of the Miller '614 Patent are cancelled or amended as a result of the Reexamination, an interference may be precluded, and if not precluded, may be unnecessary.

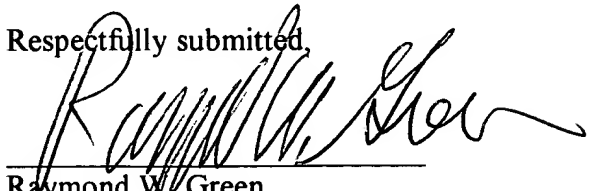
CONCLUSION

Reconsideration, reexamination, withdrawal of the rejections, and allowance of all claims, subject to a possible interference with the Miller '614 Patent, are courteously requested. Kim is *not* available as a reference under 35 U.S.C. 102(e) as of Kim's filing date, but only as a *prima facie* reference under 35 U.S.C. 102(a) as of Kim's January 28, 1999, publication date. Gager is only available as a *prima facie* reference under 35 U.S.C. 102(e) as of Gager's March 29, 1999, filing date. Interference is not appropriate with either Gager or Kim. Both Gager and Kim, however, are subject to being antedated by declarations under 37 CFR § 1.131, which declarations are presented herewith. The rejections based in whole or in part on either Gager or Kim should therefore be withdrawn. All of the rejections currently applied are based in whole or in part on either Gager or Kim.

Accordingly, all of Applicants' claims now presented, namely Claims 1-43, appear to be in condition for allowance, subject to a possible interference with Miller et al. U.S. Patent 6,130,614, if the Miller '614 Patent survives reexamination.

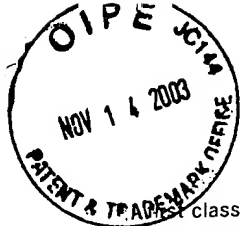
Such action is courteously requested.

Respectfully submitted,


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November 11, 2003



first class mail, with sufficient postage, in an envelope addressed to:
Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on November 11, 2003.

Date: November 11, 2003

Signature: _____

A handwritten signature in cursive script, appearing to read "R. M. W. G.", written over a horizontal line.